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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/702,049	10/30/2000	William J. Flanagan	ET00-007CIP	8546

7590

06/13/2005

Maureen Stretch  
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Natick, MA 01760

EXAMINER
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MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/702,049

Applicant(s)

FLANAGAN ET AL.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 17.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on January 13, 2005 has been entered.

The claims are referred to as numbered prior to allowance and include the previous correction under Rule 1.126. Claims 2-57 are pending.

### ***Priority***

2. This application was filed on October 30, 2000 as a continuation-in-part of various applications filed on November 16, 1998. It has been determined that all pending claims contain some continuation-in-part subject matter (i.e., subject matter that was not disclosed in the parent applications). For example, the recited "dynamic contracts manager" is not disclosed in the parent applications. Therefore, claims 2-57 are granted a priority date of October 30, 2000 for purposes of applying prior art.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of the recited "item to be developed" in claim 2 is ambiguous. It is not clear whether the item to be developed refers to the negotiation contract and/or product or service being negotiated (as suggested in claims 3 and 4) or whether the "item to be developed" is a tangible object that will physically be manufactured according to the final negotiated terms. However, claim 6 recites "a multimedia transmittal function for transmitting an item capable of being transmitted in electronic form as the item's development is being negotiated and performed." This particular recitation raises the question of whether or not the item is the product or service or the actual negotiations related to a subject of the negotiations. If the item is a product or service, it is not clear how it can be transmitted in an electronic form as the item's development is being negotiated and performed. How can an item that hasn't been completely developed yet be transmitted electronically during negotiations, especially if it's a physical product or service to be rendered? Furthermore, claim 12 recites "programming tools for automating product design and development." Again, is the product the same as the recited "item"? If so, does the design and development of the product refer to negotiations related to the product or an actual creation of a physical product to be manufactured? There are so many inconsistencies throughout the claims that claims 2-15 are deemed to be vague and indefinite.

Claim 13 recites "computer programs for tracking and analyzing costs and performance data"; however, it is not clear what the costs refer to. Are they negotiated cost terms or costs related to using the negotiations software? Also, relative to whom or what is the "performance data" measured? Is it the performance, or progress, of the negotiations process?

Claims 16-57 recite limitations that are substantially similar to those recited in claims 2-15 above; therefore, the same rejections apply.

Appropriate correction is required.

*Due to the extensive nature of the rejections under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, the following art rejection reflects Examiner's best understanding of the claimed invention.*

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 2-57 are rejected under 35 U.S.C. 102(b) as being anticipated by INSS, as disclosed in the packet of information cited by Applicant as "INSS Negotiation Protocol" (dated September 1, 1998, listed on page 3 of the IDS stamped as received on January 13, 2005).

INSS discloses an apparatus for iterative development negotiations, comprising:  
[Claim 2] a dynamic contracts manager for supplying an initial set of terms for use by a user, the terms specifying an item to be developed (Pages 6 and 8 -- Setting up the details of a negotiation, including the product or service to be negotiated, or developed, as well as the terms subject to negotiation is required); and

a multivariate negotiations system including storage space and negotiations software (Page 1 -- "INSS is a Web-based negotiation support system"; Pages 10-11, 15 -- A history of offers and messages may be accessed; therefore, offer and message information must be stored, esp. since it is used to generate a graph of the respective histories), such negotiations software executing in a processor and including an automated negotiations engine for analyzing terms, the analysis of terms comprising understanding the purpose of the terms, formatting the terms according to the purpose, and placing them into user supplied context for use by a user (Pages 2, 8-13 -- The fact that the offer history data is maintained, graphed, and used by the negotiation software to determine if an optimal agreement has been reached or suggest a Pareto-optimal agreement for both parties is indicative of the fact that INSS itself analyzes and understands the negotiation terms), the automated negotiations engine being responsive to a destination terminal for a first user communicating with the multivariate negotiations system, the destination terminal including software for sending and receiving terms along a communications path which flows through the multivariate negotiations system, the automated negotiations engine also being responsive to an initiating terminal for a second user communicating with the multivariate negotiations

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system, the initiating terminal including software for sending and receiving terms along a communications path which flows through the multivariate negotiations system, during iterative processing the automated negotiations engine recognizing the users at the destination terminal and the initiating terminal as negotiators and recognizing one of the users as a deciding entity (Pages 1, 6, 17 -- Registered users may participate in web-based negotiations using INSS. Even though each party can send various offers before receiving a response from the respective counterparty, INSS recognizes which party is officially waiting for a response, thereby recognizing a relative "deciding entity." See page 17, item 5 in particular), such automated negotiations engine further recognizing any changes in the terms and storing in the storage space the terms each terminal proposes, and recognizing the terminal to which proposal terms are being sent as the indicated terminal, and sending terms to the indicated terminal, the automated negotiations engine indicating any changes in the terms until a set of terms is acted upon in a final manner by the deciding entity (Pages 1-2, 8-13, 16, 17 -- The storage space, analysis of terms and changes thereof, and recognition of a terminal are addressed above);

[Claim 3] wherein the item to be developed comprises a product (Page 8 -- The aircraft itself is the product to be "developed," or negotiated);

[Claim 4] wherein the item to be developed comprises a service (Page 8 -- The sale of the aircraft is the service to be "developed," or negotiated);

[Claim 5] wherein the dynamic contracts manager further comprises a viewer for displaying aspects of the item as the item's development is being negotiated and

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performed (Pages 11-13 -- Graphs representing the history and progress of the negotiations process are displayed to each party);

[Claim 6] wherein the dynamic contracts manager further comprises a multimedia transmittal function for transmitting an item capable of being transmitted in electronic form as the item's development is being negotiated and performed (Page 1 -- "INSS is a Web-based negotiation support system"; therefore, all negotiations terms and messages related to the negotiated item are transmitted electronically);

[Claim 7] wherein the dynamic contracts manager further comprises an active template for supplying some of the initial terms (Pages 9-12 -- The tables showing the negotiated terms, e.g., price and warranty, are created in response to specified negotiations terms and serve as active templates for the negotiation process);

[Claim 8] wherein the active template further comprises predefined formats for designated terms (Pages 9-12 -- The tables showing the negotiated terms, e.g., price and warranty, are created in response to specified negotiations terms and serve as active templates for the negotiation process. INSS is preprogrammed with the proper format required to display the tables as shown; therefore, INSS is programmed with predefined formats for the designated terms);

[Claim 9] wherein the predefined formats further comprise functions for activating computer programs (Pages 9-13 -- The tables showing the negotiated terms, e.g., price and warranty, are created in response to specified negotiations terms and serve as active templates for the negotiation process. INSS is preprogrammed with the proper format required to display the tables as shown; therefore, INSS is programmed with



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predefined formats for the designated terms. The data from the tables is used to create a negotiations history and generate the graphs, thereby implying that INSS's predefined formats are utilized to activate the history storage and graphing computer programs);

[Claim 10] wherein the computer programs further comprise computer programs for importing and exporting data (Pages 9-13 -- The tables showing the negotiated terms, e.g., price and warranty, are created in response to specified negotiations terms and serve as active templates for the negotiation process. INSS is preprogrammed with the proper format required to display the tables as shown; therefore, INSS is programmed with predefined formats for the designated terms. The data from the tables is used, or exported, to create a negotiations history and generate the graphs, i.e., by importing the data, thereby implying that INSS's predefined formats are utilized to activate the history storage and graphing computer programs);

[Claim 11] wherein the computer programs further comprise programming tools for generating application programs (Pages 9-13 -- The tables showing the negotiated terms, e.g., price and warranty, are created in response to specified negotiations terms and serve as active templates for the negotiation process. INSS is preprogrammed with the proper format required to display the tables as shown; therefore, INSS is programmed with predefined formats for the designated terms. The data from the tables is used to create a negotiations history and generate the graphs, thereby implying that INSS's predefined formats are utilized to generate the history storage and graphing computer programs);

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[Claim 12] wherein the computer programs further comprise programming tools for automating product design and development (Page 8 -- The packaged product of an aircraft with a specified warranty period is designed and developed);

[Claim 13] wherein the computer programs further comprise computer programs for tracking and analyzing costs and performance data (Pages 9-12 -- A history of negotiated prices, or costs, and progress, or performance, of the negotiations process are analyzing and tracked);

[Claim 14] wherein the predefined formats further comprise documentation formats to be used during negotiation and development (Pages 9-13 -- The tables showing the negotiated terms, e.g., price and warranty, are created in response to specified negotiations terms and comprise documentation formats for the negotiation process);

[Claim 15] wherein the dynamic contracts manager further comprises an access control system for limiting the number of users allowed to participate in the negotiation of the terms specifying the item to be developed (Page 6 -- In the disclosed example, INSS requires users to register and limits the negotiation to two parties).

[Claims 16-29] Claims 16-29 recite limitations already addressed by the rejection of claims 2-15 above; therefore, the same rejection applies.

[Claims 30-43] Claims 30-43 recite limitations already addressed by the rejection of claims 2-15 above; therefore, the same rejection applies.

[Claims 44-57] Claims 44-57 recite limitations already addressed by the rejection of claims 2-15 above; therefore, the same rejection applies.

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**Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3623

June 9, 2005

  
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